

Appl. No. 09/648,590
Amdt. dated July 21, 2004
Reply to Office action of April 21, 2004

REMARKS

Reconsideration is respectfully requested.

The Office Action rejected claims 1-4 under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 4,794,421 by Stoudt et al. (hereinafter "Stoudt"). Applicant respectfully disagrees with the bases for the claim rejections offered in the Office Action and traverse the rejection as legally insufficient to establish anticipation or obviousness of the presently amended or newly submitted claims.

One particular advantage of Applicant's system is the ability to "prevent visible unevenness of printing from occurring in the background portion of an image" when it is printed. Page 1, Lines 27-28; Page 11, Lines 14-15. This significantly improves upon prior systems, which attempt to print uniform, solid background portions. Unfortunately, "completely uniform solid [background] printing cannot be effected owing to uneven ink coating on the transfer ribbon, variations in the energy applied to the thermal head, etc." Page 1, Lines 20-22. Consistent with the present invention, an image's background portion can be replaced for printing purposes by a pattern in which unevenness is not visually conspicuous when produced on the printer side. A portion of the image processing (in particular, background processing) occurs at the output unit (the "output unit...carries out background processing" "[w]hen printing the

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image." Page 11, Lines 9-13). Claim 1, as amended, specifies that the output unit "carries out background processing for the recognized background portion...to replace the background portion with a background pattern substantially lacking perceptible unevenness." Claim 1. Independent claims 5, 7 and 12 also provide for background image processing by the output unit to replace the background portion of the image with a background pattern that is printable substantially without perceptible unevenness. This is a patentably distinct difference from the disclosure in Stoudt.

Stoudt presents an "Apparatus and method for electrophotographically producing copies from originals having continuous-tone and other content." See Title. Stoudt's disclosure is directed to "reproduction methods and apparatus and more specifically to the improved production of copy (including black-and-white and color reproductions) of the kind having both continuous-tone (e.g., pictorial) and other (e.g., line-type) content." Col. 1, lines 20-25. Stoudt specifically addresses "reproduction" or copying of an original image having various information types, including "uniform background content." Col. 1, Lines 31-32. The final output composite image reproduces the original image, including reproduction of the background. Reproduction of the original background, as in Stoudt, is fundamentally inconsistent with replacement of the background portion, as in Applicant's independent claims 1, 5, 7 and 12.

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Rather than striving to reproduce the background of the original image in a copy, as is taught by Stoudt, Applicant's disclosure addresses replacement of the background by printing "the background portion with a discontinuous pattern" so as to "prevent visible unevenness of printing from occurring in the background portion of an image." Claims 1, 2, 3, 7-9; Spec. page 1, lines 27-28. Attempting to read Stoudt on Applicant's invention would render Stoudt ineffective for its intended purpose, which is to reproduce accurately an original image, including the background. Without disclosing all elements of the present claims, Stoudt fails to anticipate. Because Stoudt could not be modified to reflect the present claims without departing from its intended purpose, Stoudt also does not qualify as a proper reference to support any assertion of obviousness against the present claims. Stoudt addresses a specific goal (reproducing copies having varied information types; Col. 1, Lines 50-60) that is distinct from the purpose of Applicant's invention ("prevent visible unevenness of printing from occurring in the background portion of an image"; Page 1, Lines 27-28). Stoudt's disclosure teaches away from Applicant's invention.

As an additional area for distinction, Stoudt requires multiple imaging steps, exposing different portions of the original image onto different "image sectors" and then aggregating the different image sectors for transfer to a single copy sheet. Col. 16-17. Applicant employs multiple image-

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processing steps. Applicant's image processing includes printer-side processing of the background portion by the output unit.

Claim 5; Figs. 2-3. If the pattern is generated in the image side, the pattern may often be subjected to the influences of the processing such as resolution conversion, sharpness processing, color correction, etc., which ordinarily occur when the data is sent to the printer. If the pattern is generated on the printer side, as Applicant presents, there is no such undesirable influence from the processing. As an advantageous result, high density can be obtained at every other line to match the resolution of the printer.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051 (Fed. Cir. 1987). The Office Action does not establish a *prima facie* case of Stoudt anticipating the present claims or rendering them obvious, based on Stoudt alone or in combination with any other reference. Applicant asserts that independent claims 1, 5, 7 and 12 are patentable for at least the reasons set forth above. Similarly, dependent claims 2-4, 6, 8-11, 13 and 14 are patentable because they include all limitations of their respective base claims.

Because the Office Action does not present a reference that anticipates or renders obvious the invention claimed in the

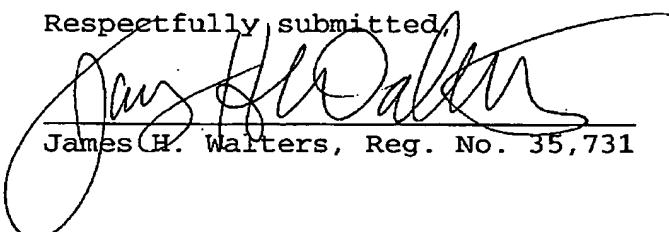
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present application, Applicant asserts that claims 1-14 are in a position for allowance and respectfully request the same. In the event that any of claims are rejected following entry and full consideration of the present amendment, Applicant respectfully requests that the Examiner provide a non-final Office Action affording Applicant an opportunity to address the grounds for rejection.

In light of the above noted amendments and remarks, this application is believed in condition for allowance. The Examiner is asked to contact applicant's attorney at 503-224-0115 if there are any questions.

Respectfully submitted,



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